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| APPLICATION NO.                                                                                             | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/769,598                                                                                                  | 01/30/2004  | Peter C. Zhu         | 56301P5007          | 8771             |
| 8791                                                                                                        | 7590        | 10/28/2005           |                     | EXAMINER         |
| BLAKELY SOKOLOFF TAYLOR & ZAFMAN<br>12400 WILSHIRE BOULEVARD<br>SEVENTH FLOOR<br>LOS ANGELES, CA 90025-1030 |             |                      | CHONG, YONG SOO     |                  |
|                                                                                                             |             |                      | ART UNIT            | PAPER NUMBER     |
|                                                                                                             |             |                      | 1617                |                  |

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                           |                  |
|------------------------------|---------------------------|------------------|
| <b>Office Action Summary</b> | Application No.           | Applicant(s)     |
|                              | 10/769,598                | ZHU ET AL.       |
|                              | Examiner<br>Yong S. Chong | Art Unit<br>1617 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on \_\_\_\_\_.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-24 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) \_\_\_\_ is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) 1-24 are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Election/Restrictions***

Restriction to the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 (in part), 2-4, 7-8, 10, 19-20, 22-23 are drawn to a germicidal composition comprising a germicidal compound where Ar is phenyl, classified in 514/699.
- II. Claims 5-6, 9, 17 (in part), 18, 21, 23 are drawn to a method of killing bacteria with a germicidal composition comprising a germicidal compound where Ar is phenyl, classified in 422/36, 514/699.
- III. Claims 1 (in part), 2-4, 11, 13 are drawn to a germicidal composition comprising a germicidal compound where Ar is 4-pyrimidinyl, classified in 514/256.
- IV. Claims 5-6, 12, 17 (in part), 18 are drawn to a method of killing bacteria with a germicidal composition comprising a germicidal compound where Ar is 4-pyrimidinyl, classified in 422/36, 514/256.
- V. Claims 1 (in part), 2-4, 14, 16 are drawn to a germicidal composition comprising a germicidal compound where Ar is 2-(2-nitro-3-formyl-phenyl), classified in 514/699.
- VI. Claims 5-6, 15, 17 (in part), 18 are drawn to a method of killing bacteria with a germicidal composition comprising a germicidal compound where Ar is 2-(2-nitro-3-formyl-phenyl), classified in 422/36, 514/699.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, III, V and II, IV, VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the germicidal compounds of the general formula can also be used in water treatment, paper

manufacture, hair colorings, wood treatment, and as a reagent for the analysis of amino acids. Furthermore, killing bacteria and disinfecting a surface can be practiced by a multitude of structurally different compounds such as chlorine, alcohols, hydrogen peroxide, iodine, and sodium hypochlorite. A search of the non-patent literature of the composition will not lead to the search of the method.

Inventions I, III, V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions I, III, V, VII are totally different compounds. Invention I discloses a compound where the Ar group is a phenyl ring, where Invention III discloses a pyrimidine ring. Invention V discloses a substituted ring with an electron withdrawing nitro group attached to it. They have different structures, thus leading to different reactivity, binding affinity, mechanism, stability, polarity, bioavailability, efficacy, solubility, and modes of action. Furthermore, the search for one invention will not lead to information regarding another invention. Because these inventions are distinct for the reasons given above and the search required for one invention is not required for another, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of

their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier.** Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer and 35 U.S.C. § 103(b)*," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong S. Chong whose telephone number is (571)-272-8513. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SREENI PADMANABHAN can be reached on (571)-272-0629. The fax

phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YSC

  
SHENGJUN WANG  
PRIMARY EXAMINER